

**REMARKS**

Claims 1 through 6, 8, 9, and 21 are pending in this Application. New claim 21 has been added. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for new claim 21 should be apparent throughout the originally filed disclosure as, for example, paragraph [21]. In addition, the specification has been amended consistent with the Examiner's comments appearing on page 3 of the August 1, 2006 Office Action. Applicants submit that the present Amendment does not generate any new matter issue.

**Objection to the Disclosure.**

The Examiner objected to the disclosure at page 5, lines 12 through 13, asserting that one of the swelling materials disclosed (RELACS™) is actually a process. In response the specification has been amended consistent with the Examiner's position, thereby overcoming the stated basis for the objection. Accordingly, withdrawal of the objection to the disclosure is solicited.

**Claims 4 through 6 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Besser et al.**

In the statement of the rejection the Examiner asserted that Besser et al. disclose a method corresponding to that claimed. As to the claim limitation requiring depositing the sealing material at a thickness substantially equal to the largest dimension of the exposed pores, the Examiner referred to Fig. 4 and then asserted "... therefore it is inherent that the dielectric material has a thickness substantially equal to a largest dimension of the exposed pores in order

to seal them as shown in fig. 4.” (Page 4 of the August 1, 2006 Office Action, first paragraph under the rejection of claims 4 through 6.) This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the **identical** disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). When imposing a rejection under 35 U.S.C. § 102, the Examiner is required to **specifically identify** wherein an applied reference is asserted to identically disclose each and every feature of a claimed invention, particularly when such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Rather, the Examiner asserts inherency.

### **There is no Inherency**

Inherency requires facts – more than pointing to Fig. 4 and announcing “...therefore it is inherent...”. The Examiner must identify a **factual** basis upon which to predicate the determination that an allegedly inherent feature is **necessarily**, repeat **necessarily**, in the applied prior art. *Crown Operations International Ltd. v. Solutia Inc.*, *supra*; *Finnegan Corp. v. ITC*, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994); *In re Rijckaert*, *supra*; *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991). With inherency, there is no

room for speculation. *Continental Can Co. USA, Inc. v. Monsanto Co., supra*. Indeed, as articulated by the Honorable Board of Patent Appeals and Interferences in *Ex parte Schricker*, 56 USPQ2d 1723, 1725 (BPAI 2000):

However, when an examiner relies on inherency, it is incumbent upon the examiner to point to the “page and line” of the prior art which justifies an inherency theory.

The only applied reference to Besser et al. is conspicuous by the **absence** of any mention of depositing a sealing material at a thickness substantially equal to a largest dimension of the exposed pores. That Besser et al. may seal the pores is not an issue. That Besser et al. deposit a layer of sealing material at a thickness equal to a largest dimension of the exposed pores is an issue, and has not been established, explicitly, inherently, or otherwise.

In relying on Fig. 4 of Besser et al. the Examiner committed two errors. Firstly, drawings are **not drawn to scale**. *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 55 USPQ2d 1487 (Fed. Cir. 2000). See, also, MPEP § 2125.

Secondly, it is apparent from Fig. 4 that what the Examiner considers to be the sealing material layer 430<sup>1</sup> is so thick that it extends **far beyond** the sidewalls in which the pores are present, thereby indicating that the thickness of the dielectric layer is considerably **greater than, not equal to**, the largest dimension of the exposed pores. Otherwise, the sealing material would exhibit a conformal appearance.

The above argued difference in manipulative steps between the claimed method and the methodology disclosed by Besser et al. undermines the factual determination that Besser et al. disclose a method identically corresponding to that claimed. *Minnesota Mining &*

---

<sup>1</sup> Reference character 440 identified by the Examiner is not a dielectric layer, but the surface of a layer (paragraph [0020]).

*Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 4 through 6 under 35 U.S.C. § 102 for lack of novelty as evidenced by Besser et al. is not factually viable and, hence, solicit withdrawal thereof.

**Claims 1 through 3 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Kim.**

In the statement of the rejection the Examiner asserted that Kim discloses a method corresponding to that claimed, including the manipulative step of sealing exposed pores in the sidewalls by depositing a swelling agent, identified by reference character 350, and heating to swell the porous dielectric layer, referring to column 7, lines 1 through 9. This rejection is traversed.

Applicants again point out that the factual determination of lack of novelty under 35 U.S.C. § 102 requires the **identical** disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, *supra*; *Crown Operations International Ltd. v. Solutia Inc.*, *supra*. Again, when imposing a rejection under 35 U.S.C. § 102, the Examiner is required to **specifically identify** wherein an applied reference is asserted to **identically disclose** each and every feature of a claimed invention, particularly when such is not apparent as in the present case. *In re Rijckaert*, *supra*; *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, *supra*. That burden has **not** been discharged. Indeed,

there is a **fundamental difference** between the claimed method and Kim's method that scotches the factual determination of lack of novelty under 35 U.S.C. § 102.

Specifically, the Examiner asserts that Kim discloses a method comprising depositing a swelling agent to line sidewalls and heating to swell the porous dielectric layer. **Where?** Saying so cannot make it so.

It is **not** apparent and the Examiner **did not specifically identify**, as **judicially required**, wherein Kim discloses or remotely suggests depositing a **swelling agent**. Kim deposits an oxide layer. What is the factual basis upon which to conclude that deposition of an **oxide layer** is identical to deposition of a swelling agent. Applicant submits that the Examiner's imposition of this rejection is entirely inconsistent with the Examiner's objection to the specification, wherein the Examiner appears to have understood a swelling process.

It should, therefore, be apparent that the Examiner **did not factually establish** that Kim discloses a method identically corresponding to that claimed, including depositing a **swelling agent**. This difference between the claimed method and Kim's method undermines the factual determination that Kim discloses a method identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., supra; Kloster Speedsteel AB v. Crucible Inc., supra.*

Applicants, therefore, submit that the imposed rejection of claims 1 through 3 under 35 U.S.C. § 102 for lack of novelty as evidenced by Kim is not factually viable and, hence, solicit withdrawal thereof.

**Declaration under 37 C.F.R. § 1.131.**

Further to traversing the imposed rejection of claims 1 through 3 under 35 U.S.C. § 102 for lack of novelty as evidenced by Kim, Applicants submit herewith a Declaration pursuant to 37 C.F.R. § 1.131 (Exhibit A) antedating the filing date of Kim, noting the difference of only about 3 months and 5 days between the filing date of Kim and the filing date of the present Application during which due diligence was exercised. Accordingly, the imposed rejection of claims 1 through 3 under 35 U.S.C. § 102 for lack of novelty as evidenced by Kim is not legally viable and, hence, should be withdrawn.

**Claims 8 and 9 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Kim.**

This rejection is traversed.

Claims 8 and 9 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Kim. The Examiner's additional statements do not cure the previously argued deficiencies of Kim. Further, the declaration under 37 C.F.R. § 1.131 antedates the filing date of Kim.

Based upon the foregoing Applicants submit that the imposed rejection of claims 8 and 9 under 35 U.S.C. § 103 for obviousness predicated upon Kim is not factually or legally viable and, hence, solicit withdrawal thereof.

**New claim 21.**


New claim 21 is clearly free of the applied prior art by virtue of its dependence upon independent claim 1, the patentability of which has been argued *supra*. Further, Applicants separately argue the patentability of new claim 21 based upon the limitations expressed therein. It is not apparent wherein Kim discloses a method comprising depositing a swelling agent in the first place, let alone a method comprising depositing a swelling agent **followed by** heating. Accordingly, claim 21 is clearly free of the applied prior art.

Based upon the foregoing it should be apparent that the imposed objection and rejections have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

  
Arthur J. Steiner  
Registration No. 26,106

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 AJS:bjs:ntb  
Facsimile: 202.756.8087  
**Date: October 16, 2006**

**Please recognize our Customer No. 20277  
as our correspondence address.**